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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,628	06/26/2001	Narinobu Kagami	209081US0PCT	4073
22850	7590	12/09/2003	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/868,628	KAGAMI ET AL.	
	Examiner	Art Unit	
	Cam N Nguyen	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 9,22-33,39 and 52-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-21,34-38 and 40-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Group I, claims 1-8, 10-21, 34-38, & 40-51, in the paper received by the Office on October 14, 2003 is acknowledged. The traversal is on the ground(s) that "Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide the reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP 803. Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups" (applicants' response page 2, middle of the page). Applicants further urged, that "If search an examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (applicants' response page 3, first paragraph). Applicants' urgings are not found persuasive for the reasons as set forth in previous office action. Since the search required for Group I is not required for Group II and/or Group III and if all three Groups are searched, an additional burden is imposed on the Office due to three different search areas being required.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9, 22-33, 39, & 52-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper dated October 14, 2003.

Specification

3. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claims 1, 8, 10, 12, & 14 are objected to because of the following informalities:

A. In claim 1, line 1, "which is" should be deleted.

B. In claim 1, line 2, --a method comprising—should be inserted before "impregnating".

C. In claim 8, line 2, "which" should be deleted and replaced thereof with --further--.

D. In claim 10, line 2, "which comprises" should be changed to --comprising--.

E. In claim 12, line 2, which comprises" should be changed to --comprising--.

F. In claim 14, line 2, which comprises" should be changed to --comprising--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112 (Second Paragraph)

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 20 & 48-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 20, 48, & 49, line 3-4, the proper Markush terminology is –is at least one selected from the group consisting of diethylene glycol, triethylene glycol, polyethylene glycol and butanediol–. See MPEP § 2173.05(h).

Claim Rejections - 35 USC § 102(b)/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 & 34-38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Parrott (US Pat. 4,720,472).

Parrott discloses a catalyst composition comprising nickel, molybdenum, and

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phosphorus impregnated on a support consisting of silica/titania on alumina wherein the molar ratio of silica to titania ranges from about 10:1 to about 0.05:1 (see col. 6, claim 1).

Product-by-process recitations in the claims are noted. While the catalyst of the reference is not made by the same process, the catalyst made is the same as the claimed catalyst. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also MPEP 2113.

Parrott discloses the claimed hydrogenation catalyst, thus anticipates the claims.

9. Claims 1-8, 10-21, 34-38, & 40-51 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kukes et al., "hereinafter Kukes", (US Pat. 4,870,044).

Kukes discloses a multilayer, fixed bed catalyst comprising (a) at least one catalytic layer of impregnated, substantially spherical alumina-containing particles and (b) at least one layer of hydrotreating catalyst particles comprising a refractory inorganic carrier material and at least one hydrogenation promoter selected from the group consisting of transition metals including Ti, Zr, Mo, W, Ni, Co, and P, at a level of from about 0.01 to about 3.0 weight percents (see col. 17, claim 1, ln 28-38 & col. 18, claim 2). Kukes also discloses a process of preparing the catalyst as described above using impregnation technique and also using ethylene glycol as a solvent for impregnation solution (see col. 7, ln 18-25).

Regarding claims 11, 13, & 15, recitation of the intended use in these claims is noted. However, the intended use limitations have no bearing on the patentability of the catalyst and method of production thereof. It is well settled that terms merely setting forth intended use for, or a property inherent in, an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art, see *In re Pearson*, 181 USPQ 641. Also, "It is contrary to spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions where uses consists merely in employment of compositions; patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him", see *In re Thrau*, 57 USPQ 324.

Citations

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Parrott (US Pat. 4,798,666), Gardner et al. (US Pat. 4,895,816), Prada et al. (US Pat. 5,229,347), Galiasso et al. (US Pat. 5,254,240), Gaffney (US Pat. 6,402,989 B1), Inooka (US Pat. 4,525,267), & Brandes et al. (US Pat. 4,831,004) are cited for related art.

Conclusion

11. Claims 1-59 are pending. Claims 1-8, 10-21, 34-38, & 40-51 are rejected. Claims 9, 22-33, 39, & 52-59 are withdrawn due to non-elected (distinct) inventions. No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (703) 305-3923. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (before finals) and (703) 872-9311 (after-final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Cam Nguyen

Primary Examiner

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Nguyen/cnn *cn*

December 3, 2003